

REMARKS/ARGUMENTS

The Non-Final Rejection has been carefully reviewed and this response addresses the Examiner's concerns stated in the Non-Final Rejection.

I. REQUEST FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136(a)

Applicants herein request an extension of time and include the large entity fee. Thus, this amendment is timely filed on or before May 19, 2008.

II. STATUS OF THE CLAIMS

Claims 1, 3-20, and 22-24, 29-42, 45 and 47 are pending in the application. Claims 2, 21, 25-28, 43, 44, and 46 were previously cancelled without prejudice.

Claims 1, 19, and 29 have been amended to further define the invention. Support for the amendments can be found in Applicants' Specification, paragraphs 63-66, among other places. No new matter has been added.

On page 1 of the Office Action, claims 43 and 44 are listed as rejected in item 6. However, claims 43 and 44 have been cancelled without prejudice. Further, there is no rejection stated for claims 43 and 44 within the Office Action.

Claims 1, 3-20, 22-24, 29-42, 45, and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendrey et al, United States Patent # 6,647,269, issued on November 11, 2003, filed on July 5, 2001, published on August 1, 2002, priority date August 7, 2000 (Hendrey), in view of Camaisa et al., United States Patent # 5,845,263, issued on December 1, 1998 (Camaisa).

Claim 47 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendrey in view of Camaisa, in further view of Kahn et al., United States Patent # 5,844,544, issued on December 1, 1998 (Kahn).

III. REJECTIONS UNDER 35 U.S.C. § 103(a)

On pages 2-11, in paragraph 2, the Office Action rejects claims 1, 3-20, and 22-24, 29-42, 45, and 47 under 35 U.S.C. § 103(a) as being unpatentable over Hendrey in view of Camaisa. Applicants respectfully point out that there is no citation for a rejection of claim 47 with respect to the combination of Hendrey and Camaisa.

It is submitted that the references, Hendrey and Camaisa, do not make obvious the invention as required by claims 1, 3-20, 22-24, 29-42, and 45 because in order for a rejection under 35 U.S.C. § 103 to be sustained, the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With respect to amended independent claim 1, and dependent claims 20, 30, and 36, it is submitted that Hendrey, Camaisa, and Official Notice do not make obvious Applicants' claimed steps of formatting, outside the client device, all unsolicited advertising information into XML elements, nor receiving the unsolicited advertising signal (formatted into XML elements) at the client device, because (1) Hendrey does not disclose any formatting whatsoever, (2) Camaisa does not make up for Hendrey's deficiency because Camaisa formats responses based on the user's capabilities, not in a single format, and (3) Official Notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known (*MPEP*, § 2144.03).

With respect to (1), Hendrey does not format advertisements into XML because Hendrey's advertisement generation subsystem is limited to generating advertising content, creating an advertisement about a particular set of goods, and generating an advertisement relevant to a

proximately located business (Hendrey, col. 4, lines 29-55), with no formatting capability described or suggested. With respect to (2), Camaisa does not make up for Hendrey's deficiency because Camaisa teaches away from formatting in a single format. Camaisa states a system that requires customized formatting (Camaisa, col. 10, lines 34-47). With respect to (3), as noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). . . official notice has been taken of a fact that is asserted to be "common knowledge" without specific reliance on documentary evidence where the fact noticed was readily verifiable, such as when other references of record supported the noticed fact, or where there was nothing of record to contradict it. See *In re Soli*, 317 F.2d 941, 945-46, 137 USPQ 797, 800 (CCPA 1963) (accepting the examiner's assertion that the use of "a control is standard procedure throughout the entire field of bacteriology" because it was readily verifiable and disclosed in references of record not cited by the Office); *In re Chevenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943) (accepting the examiner's finding that a brief heating at a higher temperature was the equivalent of a longer heating at a lower temperature where there was nothing in the record to indicate the contrary and where the applicant never demanded that the examiner produce evidence to support his statement). However, in this case, Hendrey discloses no formatting whatsoever, and Camaisa teaches away from standard formatting. Thus, what is on the record concerning standard formatting contradicts the use of it. It follows then that the combination of Hendrey, Camaisa, and Official Notice do not make obvious Applicants' claimed formatting step.

It is submitted that Hendrey and Camaisa do not make obvious Applicants' claimed unsolicited advertising information including data entry information indicating purchasing options because the combination of Hendrey and Camaisa will render Hendrey unsuitable and inoperable for the purpose for which it was intended. If when combined, the references "would produce a seemingly inoperative device," then they teach away from their combination. *In re Spornoble*, 56 C.C.P.A. 823, 405 F.2d 578, 587, 160 U.S.P.Q. (BNA) 237, 244 (CCPA 1969); see also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose)" (as cited in *Tec-Air Inc. v. Denso Manufacturing*, 192 F.3d 1353, 1360 (Fed. Cir.

1999).) Further, in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007), the Court identified "teaching away" as a strong indicator of nonobviousness. Hendrey states a device usable by prospective patrons progressing from store to store and receiving advertisements that are timely for the position of prospective patron. If combined with Camaisa, the advertisements would be blocked when the user fills out, for example, a menu request. There is no capability disclosed by either Hendrey or Camaisa that could arbitrate between volatile and non-volatile information, and thus, the two systems are not interoperable.

It is submitted that dependent claims 3-9 are patentable at least by virtue of their selected dependence upon allowable independent claim 1.

With respect to dependent claims 10 and 13, it is submitted that Hendrey and Camaisa do not make obvious Applicants' claimed receiving a service response from the transmitter or POP, the service response including executable code for allowing the client device to interact with the service, because (1) nowhere does Hendrey disclose or suggest that executable code is transmitted by a transmitter to Hendrey's mobile unit, and (2) Camaisa does not make up for Hendrey's deficiency because Camaisa does not disclose or suggest that executable code is transmitted from Camaisa's CPU to Camaisa's remote terminal. With respect to (1), Hendrey does not disclose or suggest the transmission of executable code to Hendrey's mobile unit because Hendrey limits the transmissions between the tracking system and the mobile unit to "data". A relevant passage from Hendrey follows:

The term "connection" [between a stationary unit and a mobile unit, see Hendrey, col. 3, lines 9-25] bears specific discussion. Although the notion of a connection obviously encompasses traditional voice phone calls, it furthermore encompasses any and all modalities of *data* transfer between TUs. This includes, for example, voice phone calls, video phone calls, digital camera picture transfers, general multimedia data transfers, television feeds, movies, e-mail, voice mail, prerecorded messages, data to create synthesized/reconstructed voice messages, map information, geographic coordinate data, World Wide Web content and World Wide Web pointers. (Hendrey, col. 8, line 64 – col. 9, line 10)

Executable code is not "data" but is code that acts upon data. With respect to (2), Camaisa's system is limited to transferring a menu and payment information, neither of which can be categorized as executable code.

It is submitted that dependent claims 11, 12, and 14 are patentable at least by virtue of their selected dependence upon allowable independent claim 1.

With respect to dependent claims 15, 23, and 33, it is submitted that Hendrey and Camaisa do not make obvious Applicants' claimed step of conveying unsolicited information from a transmitter as an optical signal or a diffuse infrared signal having a wavelength range of 850-1250 nanometers because neither Hendrey nor Camaisa describes the interface between the mobile unit or client and the telecommunication system infrastructure beyond the obvious requirement that the mobile unit have a wireless interface. Applicants claim a particular type of signal, an optical signal (dependent claim 15) or a diffuse infrared signal (dependent claims 23 and 33), having a particular wavelength range, 850-1250 nanometers. There are many types of wireless communications, wireless optical and diffuse infrared being only two, and many possible wavelength ranges. For example, AIRFIBER® OPTIMESH® wireless optical network transmits at 785 nanometers, while several other wireless optical systems use 1550 nanometer wavelength laser (Alwan, Jim, *Eye Safety and Wireless Optical Networks (WONS)*, White Paper 802-0004-000, AirFiber, Inc., 2001, p. 8), http://www.systemsupportolutions.com/whitepapers/WP_laser_eye_safety.pdf), neither of which is within Applicants' claimed range. For a further example, Kahn et al. states that "a wavelength band near 800 nanometers is probably the best choice for diffuse infrared communications" (Kahn et al., *Introduction to High-Speed Non-Directional Infrared Communication for Wireless Local-Area Networks*, Department of Electrical Engineering and Computer Sciences, University of California, Berkeley, CA 94720, <http://iss.bu.edu/jbc/Publications/jbc-c2.pdf>). Clearly, Applicants' choice of wavelength range is not obvious, and is out of the scope of the disclosures of both Hendrey and Camaisa. Further, the nature of a diffuse infrared signal is that it is limited to an enclosed area. Neither Hendrey nor Camaisa places such a restriction on its transmission capabilities.

It is submitted that dependent claims 16-18 are patentable at least by virtue of their dependence upon allowable independent claim 1.

With respect to independent claim 19 and dependent claims 24 and 38-40, it is submitted that Hendrey and Camaisa do not make obvious Applicants' claimed transmitter outside the client device having a link layer (independent claim 19), or a client device physical layer and a client device link layer compatible with the link layer in the transmitter (dependent claim 24), because neither Hendrey nor Camaisa describe any transmission layers, including a link layer, in the transmitter or client

device. As pointed out in *RF Protocol Design and Reconfigurable Logic Implementation for Low Power Appellants*, Alvarez et al., Facultad de Informatica UPV/EHU, San Sebastian, Gipuzkoa, Spain, 2003, "some commercial transceivers include the physical and Media Access Control layers, , " but "other transceivers need all the protocol layers". Details about the transmission layers, including Applicants' claimed link layer, are beyond the scope of both Hendrey and Camaisa.

With respect to dependent claims 22 and 32, it is submitted that Hendrey and Camaisa do not make obvious Applicants' claimed unsolicited information or advertisement conveyed from the transmitter as a diffuse infrared signal because (1) Hendrey teaches away from a diffuse infrared signal because there are no restrictions on where the recipient of the advertisement can be physically located, and (2) Camaisa does not make up for Hendrey's deficiency because Camaisa states no restrictions on the recipient either. It is well-known that several technologies exist to transmit signals wirelessly, none of which are described by Hendrey. Although Camaisa states that either radio frequency or infrared communications can be used, there are no restrictions stated or implied in their use. Applicants' claimed diffuse infrared signals are effective in closed areas like rooms, whereas neither Hendrey nor Camaisa states qualifications on wireless capability.

With respect to independent claim 29, it is submitted that Hendrey and Camaisa do not make obvious Applicants' claimed steps of receiving an advertisement in the transmitter from a service provider and conveying the advertisement by the executable code in the transmitter to the client device because (1) Hendrey does not receive advertisements and convey them by any means, but simply prepares advertisements and conveys them, and (2) Camaisa does not make up this deficiency in Hendrey because Camaisa does not receive advertisements and convey them but instead displays menus, which are neither advertisements, nor are they conveyed. With respect to (1), Hendrey does not receive advertisements and then further convey them because Hendrey's tracking system prepares the advertisements and then conveys them (Hendrey, col. 4, lines 27-32). Hendrey alludes to advertising content's being provided by the store (Hendrey, col. 3, line 66 – col. 4, line 1), but nowhere enables that capability. In fact, Hendrey teaches away from Applicants' claimed receiving the advertisement by the executable code in the transmitter from a service provider because Hendrey states that advertisements are "created" and "generated" by the advertising content generation subsystem 131. With respect to (2), Camaisa does not convey advertisements from executable code

in a transmitter because Camaisa does not disclose a transmitter having executable code. Camaisa's system includes computer readable code means for generating a menu item order signal in response to the user-generated input signals, and a transmitter for transmitting the menu item order signal. (Camaisa, col. 3, lines 62-67). Nowhere does Camaisa disclose or suggest that the transmitter has executable code.

It is submitted that dependent claim 31 is patentable at least by virtue of its dependence upon allowable independent claim 29 and dependent claim 30.

With respect to dependent claim 34, it is submitted that Hendrey and Camaisa do not make obvious Applicants' claimed diffuse infrared signal generated by modulating an electric light because (1) Hendrey does not describe how the wireless signal is generated, and (2) Camaisa does not make up for Hendrey's deficiency because Camaisa does not describe diffuse infrared or how the wireless signal is generated. It is well-known that infrared signals can be generated in a variety of ways, modulated electric light being only one of them. Neither Hendrey nor Camaisa describes any ways to generate a wireless signal, and they do not describe any limitations placed on users of their systems to accommodate Applicants' claimed diffuse infrared signal generated by modulating an electric light.

With respect to independent claim 35, it is submitted that Hendrey and Camaisa do not make obvious Applicants' claimed step of receiving the unsolicited, formatted advertisement from an infrared communication signal conveyed from the transmitter, wherein the transmitter formatted the advertisement because (1) Hendrey does not format the advertisement but instead creates it, and (2) Camaisa does not disclose a transmitter that formats an advertisement. Camaisa's transmitter is limited to routing signals from Camaisa's remote terminal to Camaisa's CPU:

As intended by the present invention, the computer 102 can be a stand-alone computer that may be fixedly or movably wall- or table- or kiosk-mounted in a dining room 118 of a restaurant. Alternatively, the computer 102 can be operably connected to a network 120, such as a local area network (LAN). In the preferred embodiment, the LAN network 120 is wireless, and the computer 102 consequently includes a radiofrequency (rf) or infrared (IR) transmitter 122 *for transmitting control signals* generated by the computer 102 in response to, e.g., manipulation of the touch sensitive portion 119. [Emphasis added] (Camaisa, col. 6, lines 27-37)

It is submitted that dependent claims 37-40 are patentable at least by virtue of their indirect dependence upon allowable independent claim 35.

With respect to claim 41, it is submitted that Hendrey and Camaisa do not make obvious Applicants' claimed wherein the information about the service is displayed to the user if the client device is running a plug-in cooperatively associated with the service because neither Hendrey nor Camaisa describe a conditional display based on a plug-in running in a mobile unit or client. Hendrey's description of a mobile unit that displays advertisements makes advertisement transmission dependent upon processing occurring external to the mobile unit, and thus does not have any display condition dependent upon a plug-in running in the mobile unit. Camaisa does not make up for Hendrey's deficiency because Camaisa's system tailoring is limited to the use of a custom scripting language and scripting compiler. The script accesses data items, such as text, pictures, video and sound, that are stored in a central custom database structure that is optimized for speed and ease of revision. (Camaisa, col. 4, lines 12-17) Plug-ins, on the contrary, are structures that give the capability of loading extra functionality into an application at run time. Camaisa teaches away from such a run-time capability by limiting tailoring options to a scripting language and compiler, which is a non-run-time capability.

With respect to dependent claim 42, it is submitted that Hendrey and Camaisa do not make obvious Applicants' claimed wherein the plug-in (running in the client device) further comprises information about a preference of the user because (1) Hendrey's user preferences, if any, are established in the tracking system which is remote from the client device (Hendrey, FIG. 1), and (2) Camaisa does not make up for Hendrey's deficiency because Camaisa does not disclose a user preference system, and restaurant preferences are established by a scripting language and compiler. With respect to (1), Hendrey's mobile unit does not contain user preferences with respect to the received advertising, including any being maintaining in a plug-in, because Hendrey's *tracking system*, not Hendrey's mobile unit, includes a profile of the user (Hendrey, col. 4, lines 27-44). With respect to (2), Camaisa does not describe a plug-in running in the client device because Camaisa's remote terminal executes code that is generic for a restaurant, as described previously, so there is no special code such as a plug-in running in the remote terminal.

It is submitted that dependent claim 45 is patentable at least by virtue of its dependence upon allowable independent claim 19.

On pages 11-13, in paragraph 3, the Office Action states that independent claim 47 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendrey in view of Camiasa, and in further view of Kahn.

With respect to independent claim 47, it is submitted that neither Hendrey, Camaisa, nor Kahn nor their combination makes obvious Applicants' claimed determining, by the client device, a user response to the predetermined information from user eye movement because (1) Hendrey and Camaisa fail to teach the user response in the form of eye movement, and (2) Kahn does not make up for Hendrey's and Camaisa's deficiencies because *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) teaches that for prior art references to be combined to render obvious a subsequent invention under 35 U.S.C. § 103, there must be something in the prior art as a whole that suggests the desirability, and thus the obviousness, of making the combination. With respect to (2), because Hendrey does not require user input into the mobile unit with respect to the advertisement, because Camaisa's user input device is limited to the touch-sensitive portion of a display screen of a monitor, a keyboard, a keypad, and a computer mouse (Camaisa, FIGs. 6-15 and col. 6, lines 21-26), and because Kahn doesn't interface with a wireless device, nothing in the prior art as a whole suggests the desirability of combining Hendrey, Camaisa, and Kahn, and in fact Hendrey teaches away from such a combination because Hendrey's purpose is to present information to the user, not to accept user input. Further, *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) teaches that the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification.

As stated previously, Hendrey and Camaisa are not interoperable. Further, Camaisa teaches away from Applicants' claimed eye movement because Camaisa states that "the primary input device of the Customer Terminal 102 is a touch screen display but could also be a mouse, keyboard or alternate input device as shown in FIG. 2". (Camaisa, col. 8, lines 46-49) The devices shown in FIG. 2 include sound and audio devices, both of which are output only.

Since Hendrey, Camaisa, and Kahn, either individually or in combination, do not teach or suggest each and every element of Applicants' independent claims 1, 19, 29, 35, and 47, and claims 3-18, 20, 22-24, 30-34, and 36-42, and 45 which depend selectively therefrom, Applicants'

independent claims 1, 19, 29, 35, and 47, and claims 3-18, 20, 22-24, 30-34, and 36-42, and 45, are not made obvious by Hendrey, Camaisa, and Kahn, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that independent claims 1, 19, 29, 35, and 47, and claims 3-18, 20, 22-24, 30-34, and 36-42, and 45, are now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to independent claims 1, 19, 29, 35, and 47, and claims 3-18, 20, 22-24, 30-34, and 36-42, and 45, for the reasons set forth above.

IV. CONCLUSION


Independent claims 1, 19, 29, 35, and 47 are believed to be in condition for allowance for the reasons provided herein. All dependent claims, 3-18, 20, 22-24, 30-34, 36-42, and 45, are also allowable for the reasons presented above, and further because they depend upon independent claims which are believed to be in condition for allowance, and are therefore also believed to be in condition for allowance.

The Commissioner for Patents is authorized to charge additional fees, including a large entity fee for an extension of time, or credit overpayment to Deposit Account No. 03-2410, Order No. 12078-142.

The following information is presented in the event that a call may be deemed desirable by the Examiner: Kathleen Chapman (617) 345-3210

Respectfully submitted,
Noah J. Ternullo et al., Applicants

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